

 received with the first end of the drawbar in coupler pocket of the model railroad car.

REMARKS

With the entry of this Amendment, original patent claims 2-5 and new claims 6-36 are pending. This Amendment constitutes a reply under 37 C.F.R. 1.111. Claims 2-9 have been previously allowed. Applicant hereby responds to the DETAILED ACTION as follows.

Line 1 of each of claims 7, 8, 15, 21, 28 and 34 have been amended to read coupler --assembly-- instead of "knuckle" as originally presented in order to be consistent with the preambles of the previous claims. There has been no other changes to these claims.

The claims 22-34 have been rejected as being based upon a defective reissue declaration. A Supplemental Declaration from the inventor accompanies this Amendment. This should overcome the rejections of claims 22-34 and should support the allowance of new claims 35 and 36.

Skipping momentarily the Examiner's rejections of claims 10, 12-16 and 18-20 under 35 U.S.C. 251, the next matter raised is the allowability of dependent claims 11, 17 and 21. Claims 11 and 17 have been rewritten into independent form including all the limitations of the base claim and each intervening claim. The only substantive change is in the form of the word "extending", which has been changed to --extends-- in each of the independent claims. Claim 19 has been similarly changed. Claim 21 depends from claim 17 and need not be put into independent form. Accordingly, these claims 11, 17 and 21 should also be in a form for allowance.

NEW CLAIMS 35 AND 36

In view of the Examiner's allowance of claim 9, indication of allowability of claims 11, 17 and 21 and comment regarding the possibility of introducing simply a spring into the rejected independent claims 10 and 16 for allowability, claims 35 and 36 are presented for examination. These claims depend directly from rejected independent claims 10 and 16 and add the provision of a spring operably coupled with the first end of the drawbar. Given the previously indicated allowability of independent claims 10 and 16 with these changes over the prior art, new claims

35 and 36 should also be allowable over the prior art. Furthermore, in view of the Examiner's comment, claims 35 and 36 should further avoid rejection under 35 U.S.C. 251.

35 U.S.C. 251 REJECTION

The Examiner maintains the rejection of claims 10, 12-16 and 18-20 under 35 U.S.C. 251 as being an allegedly improper capture of broadened claims subject matter allegedly surrendered in the application for patent on which the present issue was based.

In the pending Office Action the Examiner has responded to some but not all of the points raised by Applicant in the Appeal Brief. However, Applicant will respond first to the three specific points addressed by the Examiner in his Response to Arguments. These are set forth in the first paragraph on Page 6 of the Detailed Action.

The Examiner first states "Applicant continues to argue that the recapture rejection was improper because of a lacking of evidence of clear agreement by the inventor or his attorney with the Examiner's Statement of Reasons for Allowance." Actually, that is a misstatement. Applicant does not and did not disagree with the Examiner's stated reason for allowance. In fact, in the Appeal Brief, Applicant asserts in page 12 that **"There Was No Reason For Applicant To Have Contested The Portion Of The Examiner's Reasons For Allowance Being Relied Upon By The Examiner Since It Was Nothing More Than A Statement Of The Examiner's Obligation."** What Applicant does disagree with is the Examiner's conclusions that the one stated reason was the only possible reason for allowance, that the Examiner notified Applicant that it was the only possible reason for allowance and that by not contesting that statement, Applicant has knowingly surrendered broader patent protection.

The Examiner next states "Applicant states that the examiner's reliance on the failure to comment on the examiner's reasons for allowance is unjust and inequitable, as the rule specifically states that failure to comment is not acquiescence to why the application was allowed." The Examiner does not comment further on this. Applicant's point is that, although not obligated to do so, the Examiner took it upon himself to present a Statement of Reasons for Allowance. By Applicant's failure to respond to that statement, the Examiner is now arguing Applicant is not entitled to a broadening reissue of his claims whereas, had the Examiner said

nothing in allowing the claim, as was also entirely appropriate under the circumstances, Applicant would be entitled to a broadening reissue of his claims. As has been explained extensively elsewhere in the record, Applicant (and those other applicants who might be similarly situated) is being treated unequally with respect to those applicants whose applications are allowed without comment, as the Examiner could have done in this application. Those other applicants would clearly be entitled to a broadening reissue. The Examiner is essentially relying upon what was a boilerplate recitation of his responsibilities as an Examiner to properly examine the claims of an application as justification for now denying Applicant's statutory right to broaden a claim that was never rejected over the prior art and whose allowability has never been questioned or argued at any time during the prosecution of the underlying application.

Finally, the Examiner states that "Applicant makes the additional argument that the prosecution history shows that the Examiner did not really mean what was explicitly stated in the reasons for allowance." Again, the Examiner mistakes Applicant's argument. What Applicant argues is the fact that the Examiner's statement of reasons for allowance stated only one reason does not mean there was only one reason justifying allowance of the claim and, indeed, does not constitute evidence that it was the only possible reason for allowance, or that it was, in fact, the Examiner's only reason for allowance. These issues and other issues raised by the Examiner in his remarks will be addressed in further detail below.

The Examiner's entire case rests on his recitation of "the combination of all of the features claimed in claim 7" in his Statement of Reasons for Allowance. However, that portion of the Reasons for Allowance that he relies upon was merely a factually correct statement of the law and his obligations thereunder and was incontestable.

An Examiner is expected to review all claims for allowability over the prior art under 35 U.S. §103. 35 U.S.C. 103(a) states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art

to which said subject matter pertains. (Emphasis added.)

Under MPEP 2141.01, the Examiner “must” consider the claimed invention as a whole. This means he must consider all limitations of each claim in determining patentability. Indeed, he is not permitted to consider anything less.

The Examiner has yet to identify any difference between that portion of his Statement of Reasons for Allowance and his obligation under the statutes and the MPEP to expressly consider the claimed invention as a whole when examining claims and allowing them over the prior art. To consider original application claims 4 and/or 7 or patent claim 1 “as a whole”, one must consider each and every aspect of the claim, from its preamble through each and every element listed after the preamble.

Accordingly, the portion of the Examiner’s statement that he points to is truly nothing more than a boilerplate recitation of his obligation under the statutes, rules and MPEP. This statement is nothing more than an affirmation that he has properly analyzed the claim for allowance. As such, it does not warrant a response from the Applicant let alone a protest as being in error. What Applicant does contest is the Examiner’s current position that these two facts, this statement and the lack of response by Applicant, are relevant, let alone controlling, to the determination of recapture with respect to a claim that was never rejected over prior art.

First, Applicant traverses the unproven “facts” and unsupported conclusions the Examiner asserts arise from the statement and lack of response. On Page 7 of the Office Action, the Examiner asserts that he “clearly stated on the record ... *(he)* believed all of the features of claim 7 were necessary for allowance.” He also asserts that the statement constituted “...*the reasons that the examiner was allowing the application, namely are combination of ‘all the features claimed in claim 7.’*” (Original emphasis.) He further argues that “(t)he attempt to remove material that *the examiner* deemed necessary is in fact recapture...”. (Original emphasis.)

Actually, all the Examiner stated in his Statement of Reasons for Allowance was:

2. The following is an Examiner’s Statement of Reasons for Allowance:
the combination of all of the features claimed in claim 7, in particular

with the use of two stops in the coupling head for limiting the pivotal movement of the coupler knuckle against the spring, is not found nor suggested by any of the prior art of record, including the exhibits of the protest filed 10/10/95.

Nowhere did the Examiner state that this was his only reason for allowance as he now asserts. Nowhere did the Examiner state that all of the features of claim 7 were necessary for allowance as he now asserts. All he stated was that the combination of those features and “in particular with the use two stops on the coupling head...” is not found nor suggested by any of the prior art of record. That is an absolutely true statement of fact supporting the allowability of the claim but says nothing about what the Examiner considered or believed necessary for allowance.

Furthermore, the fact that he presented only one reason in his statement does not preclude there being other reasons for allowability and does not establish it was his only reason. Indeed, his statement refers to “Reasons”. The MPEP instructs that: “(t)he statement is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be written to specifically or impliedly state that all the reasons for allowance are set forth.” MPEP 1302.14. Any one reason for allowance is sufficient for the Examiner to be required to allow the claims. Thus, the Examiner was not only under no obligation to state all of his reasons for allowance, he was positively discouraged from stating more than one reason if he had more than one. The Examiner does not clearly state there was only one reason for allowance and there was no reason for Applicant to believe there was only one reason for allowance. There is no evidence in the record establishing either of these arguments of the Examiner. Applicant cannot be punished now for having been unable to read the mind of the Examiner at allowance.

As has been stated in the Appeal Brief and above, Applicant does not contest the reason for allowance. Applicant does contest the implication the Examiner is now trying to raise from his statement of that reason, namely, 1) the combination of all the elements of application claim 7 was the only possible reason for allowance; 2) that his statement of reasons for allowance of a claim, which had never been rejected, was not to advise Applicant that he considered the claim allowable over the prior art submitted in the protest but not made of record in the application but rather was to warn Applicant that the presence of all the limitations in application claim 7 was

the only reason for his allowance; and 3) that by failing to respond to a portion of a total statement of reason for allowance, which in isolation as the Examiner refers to it constituted nothing more than an affirmation of the Examiner's duties, Applicant somehow waived statutory rights to which he was otherwise entitled.

Applicant further traverses the newly stated proposition of the Examiner that "(t)he attempt to remove material that *the examiner* deemed necessary for patentability is, in fact, recapture, regardless of applicant's opinion as to the validity of the examiner's reasoning." The Examiner cites absolutely nothing in support of this proposition, neither the original cases he identified (*Hester Industries, In re Clement and Ball*) nor the MPEP. The issue of patentability of patent claim 1 was never in argument. Again, the issue is not what the Examiner thinks today or even what he thought when he allowed the claim but what the record as a whole shows the Applicant knowingly (and not mistakenly) surrendered.

The Examiner further argues that:

Applicant has suggested in the remarks that despite the clear and unambiguous language of the examiner in the reasons for allowance, the examiner really only meant *some* features of the combination were essential, not *all* of the features of the combination were essential.


The Examiner misconstrues Applicant's statement. Applicant's position was and remains that regardless of what reason was given by the Examiner for allowance. it is clear from the record in the underlying application that patent claim 1 was also allowable for the simple reason that none of the prior art in the application disclosed or suggested the presence of two stops as set forth in original application claim 4 and later application claim 7. The fact of the matter is, regardless of what other element or elements were eliminated from application claim 4 or application claim 7, as long as those elements included the requirement for a pair of stops (and, of course, the related drawbar and coupler head elements), the Examiner had no prior art in the application capable of being used to reject such a claim. In fact, the Examiner has already allowed independent claims 10 and 16 over the prior art before raising the recapture issue in this reissue application. Applicant did not appreciate this fact after the patent was granted.

For the foregoing reasons, reconsideration and withdrawal of all pending rejections, examination of new claims 35, 36 and allowance of the application with all pending claims 2-36 are respectfully requested.

Respectfully submitted,

ROBERT H. STAAT

21 October 2002 By: _____
(Date)


JOHN JAMIESON, JR.
Registration No. 29,546
AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.
One Commerce Square
2005 Market Street - 22nd Floor
Philadelphia, PA 19103
Telephone: (215) 965-1200
Direct Dial: (215) 965-1310
Facsimile: (215) 965-1210
E-Mail: jjamieson@akingump.com

JJJ/vbm
Enclosures

**MARKED-UP CLAIMS
IN AMENDMENT OF U.S. PATENT APPLICATION 08/999,730**

7. (Amended) The magnetically-actuated coupler [knuckle] assembly of claim 6 wherein the cantilever spring is molded from engineering plastic.

8. (Amended) The magnetically-actuated coupler [knuckle] assembly of claim 6 wherein the cantilever spring and the leaf spring are molded from engineering plastic as a unitary piece with the drawbar.

11. (Amended) [The] A magnetically-actuated coupler assembly for a model railroad car [of claim 10 further] comprising:

(a) a drawbar with first and second ends, the first end being configured for pivotal mounting within a coupler pocket of a model railroad car;

(b) a coupler head at the second end of the drawbar,

(c) a magnetically-actuated post pivotally secured to the drawbar so as to extend downward from the drawbar,

(d) a coupler knuckle pivotally secured to the second end of the drawbar with the post, the coupler head having a pair of stops which limit the pivotal movement of the coupler knuckle on the drawbar,

(e) a cantilever spring formed as an integral part of the drawbar, the cantilever spring including a first portion extending from the drawbar proximally the coupler head which curves away from the drawbar and the coupler knuckle and a free end which curves back toward the coupler knuckle sufficiently so as to constantly apply a tangential force against the coupler knuckle and urge the coupler knuckle to a closed or coupled position in all positions of the coupler knuckle between the pair of stops, and

(f) a leaf spring secured to the first end of the drawbar and [extends] extending outward and around the first end of the drawbar to form a C-shape.

15. (Amended) The magnetically-actuated coupler [knuckle] assembly of claim 10 wherein the cantilever spring and the drawbar are molded together as a unitary piece from engineering plastic.

17. (Amended) [The] A magnetically-actuated coupler assembly for a model railroad car [of claim 16 further] comprising:

a drawbar having a first end adapted to be pivotally mounted within a coupler

pocket of a model railroad car and an opposing, second end,

a coupler head formed on the second end of the drawbar,

a cantilever spring formed as an integral part of the drawbar extending from the drawbar adjacent to the coupler head;

a coupler knuckle pivotally secured to the coupler head; and

a magnetically-actuated post pivotally securing the coupler knuckle to the coupler head, the magnetically-actuated post being pivotally connected to and extending at least downwardly from the coupler head, the coupler knuckle being in constant contact with the cantilever spring to urge the coupler knuckle to a closed or coupled position, the cantilever spring having a first portion which curves away from the drawbar and a free end which curves back toward the coupler knuckle to apply a tangential force to the coupler knuckle, such that the magnetically-actuated coupler is assembled from three parts, and

the coupler head containing a pair of stops which limit the movement of the pivotally mounted coupler knuckle; and

a leaf spring secured to the first end of the drawbar and [extends] extending outward and around the first end of the drawbar to form a C-shape.

19. The magnetically-actuated coupler assembly of claim 10 further comprising a leaf spring secured to the first end of the drawbar and [extends] extending outward and around the first end of the drawbar to form a C-shape.

21. (Amended) The magnetically-actuated coupler [knuckle] assembly of claim 17 wherein the cantilever spring and the drawbar are molded together as a unitary piece from engineering plastic.

28. (Amended) The magnetically-actuated coupler [knuckle] assembly of claim 23 wherein the cantilever spring and the drawbar are molded together as a unitary piece from engineering plastic.

34. (Amended) The magnetically-actuated coupler [knuckle] assembly of claim 30 wherein the cantilever spring and the drawbar are molded together as a unitary piece from engineering plastic.